

REMARKS

In the Office Action dated 22 March 2004, the Examiner rejected claims 1-20, 22, 23, 31-37, 39, 44, and 45 as anticipated by or obvious over US Patent 6,202,308 ("Ramun"). The undersigned asks the Examiner to reconsider the prior rejection in light of the foregoing amendments and the following remarks. A separate petition for a three-month extension of time accompanies this amendment.

I. Amendments

The present amendment cancels claims 19 and 20 and amends claims 1, 7, 8, 16, 17, 18, 31, and 39. Many of these amendments are either cosmetic, non-narrowing changes or changes that broaden aspects of the claim. For example, the amendments to claims 7, 8, and 17 merely reflect changes in terminology in the claims from which they depend and do not narrow the scopes of the claims. The amendment to claim 16 deletes the additional elements added in the preceding amendment, thereby broadening the claim.

II. The Applied Art

All of the Examiner's rejections are based on a single reference, U.S. Patent 6,202,308 ("Ramun"). Ramun describes a large metal-cutting shear designed to be mounted on a backhoe. This large shear includes a series of inserts 10 that can be indexed to a particular position with respect to a fixed or moveable blade 34 or 38. These inserts 10 may be attached to one of the blades by one or more plow bolts 18, with a plow bolt filling each of the "central bores" 12 or 62 in the insert. The plow bolts are spaced equidistantly and the number of central bores in an insert is tied only to its length. Hence, for an insert 10 that is too short to span two bolts, a single bolt is used. Ramun shows one longer insert that spans three bolts and another that spans four.

III. Claims 1-8

Claim 1 calls for a cutting blade for a hand-held cutting tool configured for use with first and second mounting rods. The blade includes at least three mounting holes passing through a body. A first pair of the mounting holes are spaced by the same mounting distance as the rods, as are a second pair of the mounting holes. A first shear

edge is spaced from the first pair of mounting holes by a first distance and in a first orientation with respect to the first pair of mounting holes and is spaced from the second pair of mounting holes by a second distance and in a second orientation with respect thereto; at least one of the second distance and the second orientation differs from a respective one of the first distance and the first orientation. A second shear edge is spaced from the second pair of mounting holes by the first distance and in the first orientation with respect thereto.

The Examiner rejected claims 1-8 as anticipated by Ramun, explaining his view that "if blade 10 were rotated about an axis that is perpendicular to its length to change orientation and cutting edges, then it would meet the claim language." The inserts 10 of Ramun have at least one "central bore" 12 or 62, each of which receives a plow bolt 18 when mounted on a blade for use. The "central" position of the bore is repeatedly borne out in the specification and is shown consistently in the drawings. Inserts with a single bore have the bore positioned in the center of the insert. Inserts with multiple bores have the bores arranged centrally along a midline of the insert so the bores are aligned parallel to, and spaced equidistantly from, each of the lengthwise edges of the insert. Furthermore, the central bores are spaced equidistantly from one another along the length of each multiple-bore insert. Due to the central positioning and spacing of the bores, flipping one of the inserts will consistently position it so that a plow bolt can be received in each and every hole.

Claim 1 specifies that the first and second mounting holes had different spacing from and/or orientation with respect to the first shear edge of the blade. This is in direct contrast to Ramun's arrangement in which the central bores are consistently oriented parallel to and spaced the same distance from each of the edges of the inserts. Hence, claim 1 is distinguishable from Ramun on at least this basis. The undersigned further submits that claim 1 is unobvious over Ramun. Nothing in Ramun would motivate one skilled in the art to displace the "central" bores from their central position. As a matter of fact, the central, equidistant arrangement of the central bores is fundamental to the ability to reorient the inserts with respect to the blades. Skewing the central bores from the specified arrangement would preclude use of the insert in its intended manner. Hence, claim 1 is patentable over Ramun.

Claims 2-8 and 44 depend from claim 1 and are patentable at least by virtue of their dependence from a patentable base claim. Many of these claims are also patentable in their own right, independently of the patentability of claim 1. As noted in the prior amendment, claim 44 requires that the at least one mounting hole of the second pair that is not included in the first pair (as recited in claim 1) does not receive a mounting rod when the first and second mounting rods are received in the first pair of mounting holes. The Examiner has not explained how Ramun teaches or suggests such a feature.

IV. Claims 9-15

Claim 9 calls for a cutting blade having, among other features, a body and at least five mounting holes passing through the body and defining first, second, third and fourth pairs of mounting holes. At least one of the mounting holes of each of the first, second, third and fourth pairs of mounting holes being included in none of the other three pairs of mounting holes. Each of four spaced-apart shear edges is spaced a fixed distance from and in a fixed orientation from a corresponding one of the four pairs of mounting holes. Claim 9 also states that the blade can be reoriented to position one of the four shearing edges for cooperation with a reciprocating cutting member by attaching the blade using a corresponding one of the four pairs of mounting holes.

The Examiner acknowledges that Ramun does not teach the claimed arrangement of holes, but rejects claims 9-15 as obvious over Ramun viewed alone: "The number of holes, absent a showing of criticality, would appear to be a matter of obvious choice. Thus specifying 5 holes for the blades would have been obvious." The undersigned respectfully submits that this fails to state even a *prima facie* basis for a §103 rejection, the elements of which are spelled out in the MPEP:

To establish a *prima facie* case of obviousness three basis criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable**

expectation of success must both be found in the prior art, and not based on applicant's disclosure.

(MPEP § 2142; emphasis added.) The MPEP also specifically warns that the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." (MPEP § 2143.01.) The Examiner has neither cited any reference that suggests such a modification nor explained why anyone skilled in the art would be motivated to modify Ramun's disclosure to arrive at the claimed invention.

In addition to calling for at least five holes, claim 9 characterizes the interrelationship of these mounting holes with one another and with four shear edges. The Examiner merely speculates that it would have been obvious to add more holes to Ramun's inserts, but does not articulate any arrangement that will yield four pairs of central bores that have the particular relationships set forth in claim 9. As such, the undersigned respectfully submits that the rejection of claims 9-15 is improper.

V. Claims 16 and 17

Aspects of claim 16 are analogous to some of the aspects of claim 1. By analogy to the preceding discussion of claim 1, therefore, claim 16 is patentable over Ramun. Claim 17 depends from claim 16 and is patentable on at least that basis.

VI. Claims 18, 22, and 23

Claim 18 calls for a cutting blade that includes a body having first and second pairs of mounting points. The first pair includes a central mounting point spaced a first distance from the first shear edge and a first distal mounting point spaced a different second distance from the first shear edge. The second pair of mounting holes includes the central mounting point, which is spaced the first distance from the second shear edge, and a third distal mounting point spaced the second distance from the second shear edge.

As explained above, operation of Ramun's system is predicated on positioning of central bores an equal distance from the edges of the insert. Consequently, claim 18

and dependent claims 22 and 23 are both distinguishable from and unobvious over Ramun.

VII. Claims 31-36 and 45

Aspects of claim 31 are analogous to some of the aspects of claim 1 discussed above. By analogy to the preceding discussion of claim 1, therefore, claim 31 and dependent claims 32-36 and 45 are patentable over Ramun.

VIII. Claim 37

Claim 37 calls for a cutting blade that includes a body having, among other features, at least six mounting holes that define first, second, third, and fourth pairs of mounting holes. Claim 37 also requires that the second pair include at least one mounting hole not in the first pair; that the third pair include at least one mounting hole that is included in neither the first pair nor the second pair; and that the fourth pair include at least one mounting hole that is included in none of the first pair, the second pair and the third pair.

In rejecting claim claims 9-15, the Examiner acknowledged that Ramun failed to teach an insert with at least five holes. The undersigned cannot see, therefore, how the Examiner can contend Ramun teaches an insert having at least six mounting holes, as called for by claim 37. As Ramun neither teaches nor suggests the structure of claim 37, the undersigned respectfully submits that claim 37 is patentable over Ramun.

IX. Claim 39

Claim 39 specifies that the first mount of each blade has a first positional relationship with respect to the first shear edge and a second, different positional relationship with respect to the second shear edge. This is directly contrary to the relationship of the "central bores" to the edges of the inserts 10 in Ramun. Consequently, claim 39 is patentably distinguishable from Ramun.

X. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of

Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3848.

Respectfully submitted,
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